

In the Drawings

There are no amendments to the Drawings.

Remarks

Applicant has amended Claims 1, 3, 4, 7, 20, and 25, cancelled claim 29, and added new Claims 30 – 35. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application (see, e.g., paragraphs 14, 39, and 40). Entry of the amendment and favorable consideration thereof is earnestly requested.

The Examiner has allowed Claims 9 – 19 and 21 – 24, and indicated that Claim 7 would be allowable if rewritten in independent form. The Applicant has therefore amended Claim 7 to include the limitations of Claims 1, 5, and 6.

The Examiner has rejected Claims 25 – 27 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,088,599 to Mahler ("the Mahler patent"). The Examiner has further rejected Claims 25 – 28 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,866,541 to Ravis ("the Ravis patent") and as being anticipated by U.S. Patent No. 6,290,060 to Burtch ("the Burtch patent"). The Examiner has further rejected Claims 1, 3 – 6, 8, 20 and 29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,360,887 to Pettey ("the Pettey patent") in view of the Burtch patent, and Claim 2 as being unpatentable over the Pettey patent in view of the Burtch patent and "Itsy Bitsy Spider and Other Favorites." These rejections are respectfully traversed.

35 U.S.C. §102 Rejections

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Applicant respectfully submits that none of the prior art references cited by the Examiner includes each and every element of Claim 25 as amended.

For example, Claim 25 as amended requires a “book cover having multiple layers including a base layer, a top layer, and at least one intermediate layer, the multiple layers being substantially parallel to one another” and “a cavity for receiving at least a portion of said tray therein, said cavity defined by the multiple layers.” Nowhere in Mahler, Ravis or Burtch is any book cover taught or suggested, and certainly not a book cover including multiple layers being substantially parallel to one another and defining a cavity as described in Claim 25. At least for this reason, Claim 25 and each claim dependent therefrom cannot be anticipated by the cited references.

Furthermore, Claim 25 also requires “at least two tray protrusions extending substantially perpendicular to the direction of movement and substantially parallel to the multiple layers” and the “intermediate layer” comprising “at least two cavity protrusions extending substantially perpendicular to the direction of movement” such that when said tray is displaced toward the open position the cavity protrusions and the tray protrusions engage with each other so that said cavity and said tray are engagingly interlocked with each other.” In addition to Mahler failing to describe a book cover having multiple layers, Mahler also fails to describe the tray protrusions and cavity protrusions of Claim 25 as amended. The Examiner suggests that elements 34 and 38 in Figure 5 of the Mahler patent teach such cavity protrusions. However, elements 34 and 38 clearly are not “substantially perpendicular to the direction of movement” as required by Claim 25.

Ravis likewise fails to disclose “at least two cavity protrusions extending substantially perpendicular to the direction of movement such that when said tray is displaced toward the open position the cavity protrusions and the tray protrusions engage with each other so that said cavity and said tray are engagingly interlocked with each other.” For example, the elements 94 and 95 referenced by the Examiner and shown in Figure 14 of the Ravis patent are merely leading ends of channels or slits 87 and 88. (col. 4, lines 42 – 44 and lines 53 – 55). The Applicant respectfully submits that such leading ends of slits are not “protrusions” and also do not extend substantially perpendicular to the direction of movement as required by Claim 25.

For the above reasons, the Applicant respectfully submits that Claim 25, and dependent Claims 26 – 28, are not anticipated and should be allowed over the cited prior art. Furthermore, Applicant has added a new Claim 33 that includes each and every limitation of Claim 25 and additional limitations not disclosed in any of the cited prior art, including the “top layer” having a “height greater than a height of the base layer.” This limitation is supported at least by Applicant’s Figure 12, Figure 14, and paragraph 0052.

35 U.S.C. §103 Rejections

The Examiner has rejected Claims 1, 3 – 6, 8, 20 and 29 under 35 U.S.C. §103(a) as being unpatentable over the Pettey patent in view of the Burtch patent, and Claim 2 under 35 U.S.C. §103(a) as being unpatentable over these references in further view of “Itsy Bitsy Spider and Other Favorites.” The Applicant respectfully disagrees.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Claim 1 requires, among other limitations, “a book for providing printed content to a user having a holding apparatus for a storage medium comprising” “a book cover having an interior cavity for receiving said storage medium holder, said book cover being slideable.” Neither Pettey nor Burtch teach or in any way suggest these limitations.

First, both Pettey and Burtch are directed towards improved means to carry CD’s, and do not teach or suggest a traditional book (e.g., a literary work) having printed content. While Pettey discloses CD folder that may take the shape of a “booklet,” this is not a book as described in Applicant’s Claim 1 and is instead constructed for the sole purpose of storing a CD or DVD.

Second, neither Pettey nor Burtch teach or suggest a “book cover being slideable.” It is well settled that “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Neither reference teaches a book cover, and certainly not a book cover that is slideable. To further clarify this limitation, the Applicant has

amended Claim 1 to indicate that the book cover is slideable to an open position "relative to a binding of the book."

Because at least the above discussed limitations are not taught or disclosed in any of the cited references, the Applicant respectfully submits that Claim 1, and Claims 2 – 6, 8 and 30 which depend therefrom, should be allowed.

Claim 20 requires, among other limitations, a "book having a holding apparatus for a storage medium comprising" "a book cover having an interior cavity for receiving said storage medium holder." Claim 20 further requires "a book binding; and a plurality of pages providing printed content; wherein each of said book cover and said plurality of pages are bound to said book binding." Neither Pettay nor Burtch teaches or suggests a book as described in Claim 20, or any book having "a book binding" and "a plurality of pages" "wherein each of said book cover and said plurality of pages are bound to said book binding."

One embodiment of the invention taught in Pettay includes a compact disc folder 70 that it contains a removeable booklet 72 that may be held within a booklet-receiving pocket 97 of the folder 70 so that the booklet 72 lies adjacent to the compact disc 40 held within a disc-receiving pocket 74, when the folder 70 is closed. (Figure 10; col. 2, lines 5 – 41). However, the folder of Pettay capable of holding a removeable booklet is in no way analogous to the book of Claim 20 that requires "a book cover having an interior cavity for receiving said storage medium holder", "a book binding," and a plurality of pages" "wherein each of said book cover and said plurality of pages are bound to said book binding." Other embodiments disclosed in Pettay provide that a "page portion 14" may be "stapled" or stitched to a "cover 12" (col. 4, lines 55 – 58). However, this does not teach a "book binding" and "plurality of pages" "wherein each of said book cover and said plurality of pages are bound to said book binding" as required by Claim 20. As such, the Applicant respectfully submits that Claim 20, and new dependent Claims 31 and 32 are patentable over Pettay and Burtch.

It is respectfully submitted that claims 1 – 28 and 30 – 35, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,



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